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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,638	05/14/2001	John Dapron	A13399 US (C06123/119964)	8768

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 11/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/854,638

Applicant(s)

DAPRON ET AL.

Examin r

My-Chau T. Tran

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-- The MAILING DATE of this communication appears on th cover sheet with the correspondenc address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) 39-112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 and 113-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/6/03 has been entered.
2. Applicant's amendment filed 8/6/03 in Paper No. 12 is acknowledged and entered. Claims 1, 13-16, 30, and 33-38 are amended by the amendment. Claims 113-117 are added by the amendment.
3. Claims 1-117 are pending.

Election/Restrictions

4. Claims 39-112 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.
5. It is noted that applicant did not cancel the nonelected claims as requested in the Final Office Action (mailed 5/02/03). The requirement is reiterated below:

“This application contains claims 39-112 are drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include

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cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01”.

Therefore, appropriate action is required.

6. Claims 1-38 and 113-117 are treated on the merit in this Office Action.

Withdrawn Rejections

7. The previous rejection under 35 USC 103(a) as being obvious over Bioprobe International, Inc. (WO 92/03732) for claims 1-38 has been withdrawn in view of applicant's amendments of claim 1 and the newly added claims 117. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

8. The previous rejection under 35 USC 103(a) as being obvious over Bioprobe International, Inc. (WO 92/03732) in view of Döbeli et al. (US Patent 5,047,513) for claims 22, 24-25 and 33-34 has been withdrawn in view of applicant's amendments of claims 1 and the newly added claims 117. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

New Rejections

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claim 117 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “some of” of claim 117 is a relative term, which renders the claim indefinite. The term “some of” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The boundary of the term “some of” is unclear in that the upper limit is not known (e.g. the term “some of” would encompass “all”).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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12. Claims 1-9, 11-38, and 113-116 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sundberg et al. (US Patent 5,624,711).

Sundberg et al. disclose a platform comprise of a solid support (substrate) and a polymer film (polymer matrix) (col. 15, lines 31-67 to col. 6, lines 1-45) (referring to claim 1). Sundberg et al. disclose several different modes of attachment of the polymer films to the surfaces of the solid support, and one mode of attachment is covalently attachment (col. 15, lines 53-58; fig. 2) (referring to claims 1 and 114). Additionally the density produced from the covalent attachment of the polymer to the surface of the solid support is considered an inherent feature of the polymer (col. 16, lines 34-37) (referring to claims 1-4). Some of the polymers in the polymer film are crosslink to each other (col. 15, lines 44-48) (referring to claim 115). The solid support comprises organic or inorganic materials such as glass or plastic and in format such as multiwell plates (col. 11, lines 20-27) (referring to claims 8-9, 11-15, and 113). With regard to claim 9, the format of the multiwell plate such as 96, 384, or 1536 wells are would be a choice as experimental design and is considered within the purview of the prior art. Further, the polymer films are tailored to provide properties for biological assays (referring to claim 116) (col. 2, lines 45-46; col. 16, lines 32-33; col. 17, lines 41-49). Thus the platform of Sundberg et al. anticipates the presently claimed platform.

Alternatively, the claimed invention differs from the prior art teachings only by the recitation of "*the density of the polymer matrix on the substrate of at least $2\mu\text{g}/\text{cm}^2$* ". This claimed limitation appears to be the same or obvious variations of the reference teachings, absent a showing of unobvious differences. The density of the polymer on the substrate is considered an obvious optimization process that is in purview of the prior art (col. 14, lines 2-6).

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Additionally, the claimed limitation of claim 9 wherein the multiwell plate has a format of 96, 384, or 1536 wells is considered an obvious variation of the reference teachings because such format are well known in the prior art. The office does not have the facilities and resources to provide the factual evidence needed in order to determine and/or compare the specific activities of the instant versus the reference with regard to the density of the polymer and the format of the multiwell plate. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed limitations with regard to the density of the polymer and the format of the multiwell plate are different from the one taught by prior art and to establish the patentable differences. See *in re Best* 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ2d 1922 (PTO Bd. Pat. App. & Int. 1989).

13. Claims 1, 11, and 115 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (US Patent 6,074,541; *filing date of 08/12/1997*).

Srinivasan et al. disclose a platform comprise of a solid support (substrate) and preformed polymer (polymer matrix) (col. 3, lines 10-12) (referring to claim 1). The preformed polymers are covalently attached to the surface of the solid support (col. 5, lines 10-13). The preformed polymers are crosslinked to each other (col. 3, lines 10-12, and 21-30) (referring to claim 115). The solid support includes inorganic materials such as glass (col. 5, lines 19-21) (referring to claim 11). Thus the platform of Srinivasan et al. anticipates the presently claimed platform.

14. Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Siuzdak et al. (US Patent 6,288,390 B1; *filing date of 03/09/1999*).

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Siuzdak et al. disclose a porous silicon plate (substrate) for use in MALDI mass spectrometry (col. 7, lines 64-67 to col. 8, lines 1-14) (referring to claim 10). The plate is coated with an olefin to produce a coated substrate (polymer matrix) (col. 15, lines 21-26). The olefin is bonded to the silicon (covalent attachment). Thus the plate of Siuzdak et al. anticipates the presently claimed platform.

15. Claim 117 is rejected under 35 U.S.C. 102(b) as being anticipated by Sundberg et al. (US Patent 5,624,711).

Sundberg et al. disclose a platform comprise of a solid surface (substrate) and a polymer film (polymer matrix) (col. 15, lines 31-67 to col. 6, lines 1-45) (referring to claim 117).

Sundberg et al. disclose several different modes of attachment of the polymer films to the solid surfaces, and one mode of attachment is a combination of different types of attachment wherein some of the polymers are covalently attach to the solid surface and some of the polymer are crosslink to each other (col. 16, lines 23-25; fig. 8-9) (referring to claim 117). Further, the polymer films are tailored to provide properties for biological assays (e.g. ligand attached to the polymer film) (col. 2, lines 45-46; col. 16, lines 32-33; col. 17, lines 41-49). Thus the platform of Sundberg et al. anticipates the presently claimed platform.

Response to Arguments

16. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

mct
November 3, 2003


ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600